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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/351,617 07/12/99 MEHTA

V 15966-518-(C)

EXAMINER
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HM12/0705

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PERSONALITY P	
ART UNIT	PAPER NUMBER

1627  
DATE MAILED:

07/05/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## 1627

Part of Paper No. 8

Art Unit: 1627

1. Applicant's election without traverse of group I, claims 1-27 and 31, in Paper No. 7 is acknowledged.

***Election/Restriction***

2. This application contains claims directed to the following patentably distinct species of the claimed invention: Applicants are further requested a single species from the following A, B, C and D, of claims 1-27.

A) cell lysate (claim 2) or population of cells or single cell (claim 3).

*Cancelled* The cells and cell lysate claimed are distinct from each other because they are structurally and functionally different and do not require the other for ultimate use, the species election for examination purposes as indicated is proper.

B) If claim 3 is elected applicants are further requested to elect mammalian cells or yeast cells or insect cells.

*Cancelled* The different cells are distinct from each other because they are structurally and functionally different and do not require the other for ultimate use, the species election for examination purposes as indicated is proper.

C) Applicants are requested to elect one type of library, i.e., combinatorial library of nucleic acids (claim 21); combinatorial library of polypeptides (claim 22); combinatorial library of small organic molecules (claim 23). *elected*

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The different libraries are distinct from each other because they are structurally different and do not require the other for ultimate use, the species election for examination purposes as indicated is proper.

D) Applicants are further requested to elect a single species of reporter gene claimed in claim 25.

*Amended*  
The different reporter genes are distinct from each other because they are structurally different and do not require the other for ultimate use, the species election for examination purposes as indicated is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 12-19, 24, 26-27 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).
5. Applicant is required to reply to this restriction requirement within 30 days of mailing this action. See MPEP 809.2(a):

Any inquiry concerning this communication should be directed to P. Ponnaluri whose telephone number is (703) 305-3884. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached at (703)308-2439. The fax number for this group is (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, a dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Jyothsna Venkat, Ph.D., Supervisory Patent Examiner at [jyothsna.venkat@uspto.gov](mailto:jyothsna.venkat@uspto.gov) or 703-308-2439. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.



P. Ponnaluri  
Patent Examiner  
Technology center 1600  
Art Unit 1627

26 June 2000



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: P. Ponnaluri

ART UNIT: 1627

SERIAL NUMBER: 09/351,617

FAX/TELECOPIER NUMBER: (703) 305-3704

**PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY  
FOR RESPONSES TO RESTRICTIONS.**

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